

SUPPORT FOR THE AMENDMENTS

Support for the amendment of Claim 1 is found on page 1,[0002], of the specification.

Claims 1-4 are amended to use wording and structure consistent with U.S. patent law practice.

Claims 5- are new and are supported as follows:

Claim 5 is supported in [0008, first paragraph] in the specification.

Claim 6 is supported in [0008, second paragraph], in the specification.

Claim 7 is supported in [0009], in the specification.

Claim 8 is supported in [0010], in the specification.

Claim 9 is supported in [0011, second paragraph], in the specification.

Claims 10 and 11 are supported in [0011,second paragraph], in the specification.

Claims 12 and 13 are supported in [0012, second paragraph], in the specification.

Claim 14 is supported in [0012, paragraphs 3 and 4], in the specification.

Claim 15 is supported in [0016 to 0022], in the specification.

Claim 16 is supported in [0023, third paragraph], in the specification.

Claim 17 is supported in [0024 to 0026], in the specification.

Claim 18 is supported in [0028, second paragraph], in the specification.

Claims 19 and 20 are supported in [0031], in the specification.

REMARKS/ARGUMENTS

The presently claimed invention is directed to a method for producing mechanical part involving sizing a sintered metal unit. A method having a sizing operation employing a lubricating oil with improved machinability and rust preventative properties is sought.

The claimed invention addresses this problem by providing the method described in Claim 1 and claims dependent thereon. Applicants have shown in Tables 1-1 and 1-2 in the

specification that the lubricating oils according to the claimed invention provide significantly improved rust prevention and coefficient of friction compared to conventional lubricating oils. Therefore when employed in the method according to Claim 1 and claims dependent thereon, significant improvement in sizing performance would be expected. No such method is disclosed or suggested in the cited references.

The rejection of Claims 1 and 2 under 35 U.S.C. 103(a) over JP 10-279979 is respectfully traversed.

JP 10-279979 describes a rustproofing and press working lubricant for application to sheet metal for press working and degreasing [0006]. This reference is directed to an article which is further downstream in a production cycle in contrast to the sintered metal unit according to the claimed invention. Applicants respectfully submit that nowhere does the cited reference disclose or suggest a method for sizing a sintered metal unit as presently described in the above-identified application. Moreover, nowhere does the cited reference disclose, suggest or provide motivation that would have led one of ordinary skill in the art at the time of invention, to have derived the method for sizing of the presently claimed invention. The problem addressed by JP 10-279979 is different from that of the claimed invention and therefore one would not have been motivated to look to this reference to solve the problem addressed by the Applicants in this invention.

Accordingly, Applicants respectfully submit that the cited reference can neither anticipate nor render obvious the method of the presently claimed invention and withdrawal of the rejection of Claims 1 and 2 under 35 U.S.C. 103(a) over JP 10-279979 is respectfully requested.

The rejection of Claims 3 and 4 under 35 U.S.C. 103(a) over JP 10-279979 in view of Deckman et al. (U.S. 2004/0038833) is respectfully traversed.

The deficiencies of the primary reference is described above. The Office has cited Deckman to show a lubricant containing a thiadiazole. Deckman describes a lubricating oil composition for an internal combustion engine [0004]. Applicants respectfully submit that nowhere does this secondary reference disclose or suggest a method for sizing a sintered metal unit and therefore this reference does not cure the deficiencies of the primary reference.

Applicants respectfully call the Examiner's attention to the following excerpt from the Office's own discussion of "**Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.***"

"The rationale to support a conclusion that the claim would have been obvious is that **all the claimed elements were known in the prior art** and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention.⁴³ "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does."⁴⁴ **If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art,**" (Federal Register, Vol. 72, No. 195, page 57529) **(Bold added)**

Applicants respectfully submit that as discussed above, the cited combination of references do not disclose or suggest all the claimed elements of the present invention and therefore according to the above KSR guidelines, a conclusion of obviousness cannot be supported. As the cited combination of references does not anticipate nor render the claimed invention obvious, withdrawal of the rejection of Claims 3 and 4 under 35 U.S.C. 103(a) over JP 10-279979 in view of Deckman et al. (U.S. 2004/0038833) is respectfully requested.

The rejection of Claims 3 and 4 under 35 U.S.C. 103(a) over JP 10-279979 in view of Cahoon et al. (U.S. 5,484,542) is respectfully traversed.

Cahoon is cited to show a composition containing a benzotriazole. This reference describes sulfurized overbased products which are useful as extreme-pressure and rust-preventative agent. However, Applicants respectfully submit that nowhere does this secondary reference disclose or suggest a method for sizing a sintered metal unit and therefore this reference does not cure the deficiencies of the primary reference. Accordingly, Applicants respectfully submit that the cited combination of references does not meet the KSR guidelines to support a conclusion of obviousness and withdrawal of the rejection of Claims 3 and 4 under 35 U.S.C. 103(a) over JP 10-279979 in view of Cahoon is respectfully requested.

Applicants note the Office's objection to Claim 4 as being in improper form. Applicants respectfully note that Claim 4 was amended to be of proper form in the Preliminary Amendment filed July 11, 2006 with this application. Applicants also note that a corrected English translation of the specification, including the original version of the claims, was filed September 21, 2006. Claim 4 in the current listing of claims is an amendment of the claim as presented in the Preliminary Amendment. If this situation requires further clarification or amendment, Applicants respectfully request the Examiner to contact Applicants U.S. representative at the telephone number listed with the Customer number below, to quickly resolve this issue.

Application No. 10/585,637
Reply to Office Action of September 5, 2008

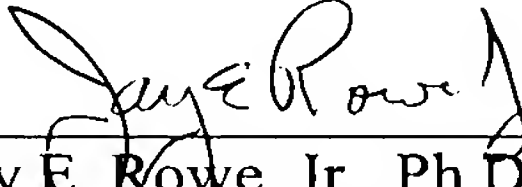
Applicants respectfully submit that the above-identified application is now in
condition for allowance and early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)



Jay E. Rowe, Jr., Ph.D.
Registration No. 58,948